

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fitzpatrick et al. )  
)  
For: Determining Availability of )  
Members of a Contact List in a )  
Communication Device )  
)  
Serial No.: 10/749,083 )  
)  
Filed: December 30, 2003 )  
)  
Examiner: Aminzay, S. )  
)  
Art Unit: 2618 )

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

**APPELLANTS' BRIEF**

This brief is in furtherance of the NOTICE OF APPEAL, mailed on February 1, 2007.

Any fees required under 37 C.F.R. §41.20, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
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## **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

## **II. RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

## **III. STATUS OF CLAIMS**

### **A. Status of all claims in the proceeding**

1.	Claims rejected:	1-21
2.	Claims allowed:	none
3.	Claims withdrawn:	none
4.	Claims objected to:	none
5.	Claims cancelled:	none

### **B. Identification of claims being appealed**

The claims on appeal are: 1-21

## **IV. STATUS OF AMENDMENTS**

No Amendments have been filed subsequent to the recent final rejection, dated September 1, 2006.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention (claim 1) pertains to a method of determining availability of members of a contact list (236) in a wireless communication system (114). The method includes determining (610; page 10, lines 14-19) an availability status of members of a contact list by receiving messages at a controller (112) that indicate changes in availability of client devices (118, 122, 126) associated with the contact list (528), where the contact list corresponds to a particular client device (118). Information regarding the availability of the client devices (122, 126) is then transmitted from the controller (112) to the particular client device (118) without a request from the particular client device (118) only when a change has occurred (page 11, lines 20-22) in the availability of one or more of the client devices (122, 126) (page 11, lines 8-16).

A further aspect of the present invention (claim 5), which is being appealed, pertains to a method of indicating availability of a wireless client device (118) that is associated with a contact list (528, 530, 532) in a wireless communication system (114). The method includes detecting (312; page 8, lines 9-11) a change in availability of the wireless client device (118). When a change in availability of the wireless client device is detected, a message is then transmitted (314) from the wireless client device (118) to a controller (112), where the message signals the change in availability to the controller (page 8, line 24 to page 9, line 3). A message indicating the availability of the other client devices is then received (420) from the controller (112), based on a periodic determination of whether changes in availability of other client devices associated with the contact list have occurred (page 9, lines 18-21) and only when changes in availability of the other client devices have occurred (page 9, lines 11-12).

A still further aspect of the present invention (claim 15), which is being appealed, pertains to a method of updating the availability of members of a contact list (236) in a wireless client device (118). The method includes receiving (page 9, lines 17-19) from a controller (112) a wireless message concerning the availability of other client devices (122, 126), which are

associated with the contact list (236, 528), only when a change has occurred (page 12, line 24 to page 13, line 2) in the availability of at least one of the other client devices, where the receiving is based on a periodic (page 13, lines 6-10) determination of whether changes in availability of other client devices (122, 126) associated with the contact list (236, 528) have occurred. Information from the wireless message concerning the availability of the other client devices (122, 126) is then stored in a memory (232) of the wireless client device (118) (page 9, lines 19-21).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 1-21 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Crockett et al., US Patent No. 6,873,854, in view of Florkey et al., US Patent No. 6,990,353.

## **VII. ARGUMENT**

### **A. Rejections under 35 U.S.C. 103**

1. Whether claims 1-21 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Crockett et al., US Patent No. 6,873,854, in view of Florkey et al., US Patent No. 6,990,353.

The Examiner has rejected claims 1-21, under 35 U.S.C. §103(a), as being unpatentable over Crockett et al., US Patent No. 6,873,854, in view of Florkey et al., US Patent No. 6,990,353. However contrary to the Examiner's assertions, the combination of references fail to make known or obvious each and every feature of the claims. Furthermore, the Examiner has failed to articulate a proper motivation to combine, where the individual references are each directed to disparate solutions to different types of problems, and while the Examiner has alleged a combination, the alleged combination has not been shown to be suitably incorporated into the base reference in a manner which is contextually consistent and/or combinable. Consequently, the applicants would contend that the claims have not properly been shown to be obvious in view

of the noted references, and as a result would respectfully request that the rejection be vacated.

#### Claims 1, 3 and 4

More specifically, in rejecting the claims, the Examiner appears to allege the separate presence across multiple references of individual features in a piece meal fashion, without regard as to any contextual consistency that could be said to suggest that the claimed combination of features would be known or obvious. For example, the primary reference is silent as to any contact list, and alternatively refers to a member list, which is described in the reference as being a list of members to be invited to participate in a call (see col. 2, lines 13-15). However, this is not the same as providing or making known an availability status of members of a contact list (claim 1), or correspondingly an availability of a particular wireless client device (claim 5) or other client devices (claims 1, 5 and 15) in the context of the present application in so far as the member list as taught by the reference does not concern itself with the communication of an associated status of availability. In other words, a list of people to be invited to a call does not convey any status concerning the availability of members to be invited, but alternatively conveys an indication of the desire for someone else (i.e. the person doing the inviting) to have the particular members participate in the call. In essence, the availability status of member in a member list is irrelevant relative to Crockett et al., '854, in so far as the same is not conveyed to the particular user, which is requesting that the members in the member list be added to the group call.

Consequently, to the extent that the secondary reference, Florkey et al., '353, might allow for the communication of status update information, when a change has occurred, the same is irrelevant with respect to the primary reference, in so far as it relates to circumstances that are contextually inconsistent with the operational circumstances of the primary reference. In other words, an availability status with respect to a buddy list is unrelated to a member list for adding members to a group call, relative to Crockett et al., '854, where the member list associated with adding members to a group call is unconcerned with communicating (transmitting or receiving) to or from a particular client device information regarding availability status of the client devices

associated with the contact list of the particular device, such as only when a change has occurred as provided in each of at least independent claims 1, 5 and 15 of the present application. Hence, the applicants' concerns regarding the suitability of combining the references for the alleged purpose of making known each and every feature of the claims, and the applicants' allegations that the Examiner is attempting to piece together disparate elements, taken separately or viewed as individual elements, which are contextually inconsistent where a teaching to combine should at least relate to a contextually consistent combinable environment.

#### Claim 2

In addition to the reasons noted above with respect to claim 1, the Examiner particular rejection of claim 2 is very enlightening, and helps illustrate the manner in which the Examiner looks for elements in isolation without regard to contextual consistency. More specifically, with regard to claim 2, instead of finding relative teachings with respect to a queue in a context which is consistent with the claims, the Examiner alternatively provides citations to instances where the cited references discusses a query being made. A query having been made does not generally make known the storage of elements in a queue. Consequently, the Examiner's rejection of claim 2 is similarly problematic, and as noted above helps to further highlight the general nature of the Examiner's rejection with respect to claim 2 and the other claims, where the Examiner appears to disregard the context, and merely looks for the presence of similarly named elements without regard to whether one skilled in the art would be motivated to combine them in a way which would make obvious the corresponding claim(s). As a result, the Examiner's rejection of claim 2 should similarly be vacated.

#### Claims 5-21

Claims 5-21 corresponding either directly or indirectly with independent claims 5 and 15, are similarly allowable for the same reasons noted above with respect to claims 1, 3 and 4, and the corresponding discussion of the claimed communication and/or management of the

availability of members and/or client devices in association with a contact list. Specifically, references to independent claims 5 and 15 have been additionally noted above with respect to the discussion associated with the claims related to independent claim 1. Those arguments are expressly incorporated herewith in relation to claims 5-21, as they have been previously related to those claims. However claims 5-21 are additionally being separately argued to the extent that independent claims 5 and 15, as well as the associated dependent claims, additionally provide for a periodic determination with respect to whether there are any changes in availability that would be used to additionally manage the circumstances in which a message is communicated indicating the respective availability associated with members and/or client devices associated with a particular contact list. Such an additional feature, provides a still further distinction which precludes the applicability of the cited references in making known or obvious each and every feature of the claims. Correspondingly, vacating the Examiner's rejection of claims 5-21 is still further appropriate.

### Conclusion

In view of the above analysis, the applicants would assert, that the Examiner has failed to establish that any of the cited references either separately or in combination make known or obvious the presently pending claims. The applicants would respectfully request that the Examiner's decision to finally reject and/or object to the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

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## VIII

## APPENDIX OF CLAIMS

The following is the text of the claims involved in this appeal:

1. A method of determining availability of members of a contact list in a wireless communication system, wherein the method comprises:

determining an availability status of members of a contact list by receiving messages at a controller that indicate changes in availability of client devices associated with the contact list, the contact list corresponding to a particular client device; and

transmitting from the controller to the particular client device without a request from the particular client device information regarding the availability of the client devices only when a change has occurred in the availability of one or more of the client devices.

2. The method according to claim 1, wherein the method includes:

storing the changes in availability of the client devices in a queue; and  
periodically transmitting the changes in availability that are in the queue to the particular client device.

3. The method according to claim 1, wherein the method includes:

starting a timer;  
storing the changes in availability of the client devices in a queue;  
when the timer expires, transmitting the changes in availability that are in the queue to the particular client device; and



resetting the timer.

4. The method according to claim 1, wherein, if the transmitting has been performed, the method includes delaying a subsequent transmission of contact list availability information until a time interval has passed.

5. A method of indicating availability of a wireless client device that is associated with a contact list in a wireless communication system, wherein the method comprises:

detecting a change in availability of the wireless client device;

when a change in availability of the wireless client device is detected, transmitting a message from the wireless client device to a controller, wherein the message signals the change in availability to the controller; and

receiving from the controller, based on a periodic determination of whether changes in availability of other client devices associated with the contact list have occurred and only when changes in availability of the other client devices have occurred, a message indicating the availability of the other client devices.

6. The method according to claim 5, wherein the method further includes receiving from the controller a message that indicates the availability of the other client devices associated with the contact list, the message including all changes in availability of the other client devices since a previous periodic determination of changes in availability of the other client devices.

7. The method according to claim 5, wherein the method further includes receiving from the controller a message that indicates only changes in the availability of other client devices associated with the contact list.

8. The method according to claim 5, wherein the method includes detecting a change in availability when the client device is being turned off.

9. The method according to claim 5, wherein the method includes detecting a change in availability when the client device is moving out of a geographic service area of the wireless communication system.

10. The method according to claim 5, wherein the method includes detecting a change in availability when the client device moves out of a first service area and into a second service area of the wireless communication system.

11. The method of claim 10, wherein the first service area is a digital service area and the second area is an analog service area.

12. The method according to claim 5, wherein the client device is associated with more than one contact list.

13. The method according to claim 5, wherein the transmitting is performed only when a change in availability of the client device is detected.

14. The method according to claim 5, wherein the method is performed by a mobile telephone.

15. A method of updating the availability of members of a contact list in a wireless client device, wherein the method comprises:

receiving from a controller a wireless message concerning the availability of other client devices, which are associated with the contact list, only when a change has occurred in the availability of at least one of the other client devices, the receiving based on a periodic determination of whether changes in availability of other client devices associated with the contact list have occurred; and

storing information from the wireless message concerning the availability of the other client devices in a memory of the wireless client device.

16. The method according to claim 15, wherein the method includes:

detecting a change in availability of the wireless client device; and

when a change in availability of the wireless client device is detected, transmitting a wireless message from the wireless client device to the controller, wherein the message signals the change in availability of the wireless client device to the controller.

17. The method according to claim 16, wherein the method includes detecting a change in availability when the wireless client device is being turned off.

18. The method according to claim 16, wherein the method includes detecting a change in availability when the wireless client device is moving out of a geographic service area of the wireless communication system.

19. The method according to claim 16, wherein the method includes detecting a change in availability when the wireless client device moving out of a first service area and into a second service area of the wireless communication system.

20. The method of claim 19, wherein the first service area is a digital service area and the second area is an analog service area.

21. The method according to claim 15, wherein the method is performed by a mobile telephone.

## **IX EVIDENCE APPENDIX**

None

**X      RELATED PROCEEDINGS APPENDIX**

None